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VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER FOX, CHARLES A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,031	Applicant(s) BUDNY ET AL.	
	Examiner Charles A. Fox	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20060519 & 20090130</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the several degrees of freedom must be shown or the feature(s) canceled from the claim(s). An axis should be shown for each pivotal joint along with appropriate directional arrows. Linear movement of parts must also be shown along with directional arrows. All new elements must be in the specification and readily determinate from the existing drawings in order to not be considered new matter. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. **The objection to the drawings will not be held in abeyance.**

Specification

The disclosure is objected to because of the following informalities: the first paragraph should be amended to show the entire chain of priority. Incorporation by reference of the priority documents in this application is not proper and should not be used. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for several degrees of freedom, does not reasonably provide enablement for how many this may be. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to construct the invention commensurate in scope with these claims. It is not clear what type of handler would or not infringe these claims as no specific handler is disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. Specifically claim 1 in line 2 has the phrase “essentially including” which encompasses elements that may or not be present but sets no clear boundary to the claim. Further in line 6 the phrase “characterized in” is used

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to further define the structure of the device. It is not clear if this is the end of the claims preamble and the start of the limitations or not. As most every thing that is listed prior to the phrase "characterized in" is disclosed as being prior art by the applicant the limitations after the phrase are being treated as the improvement to existing filling, emptying handling and buffer devices in the tobacco industry. Clarification is required.

The phrase "characterized in" is found in every dependent claim as well. It is not clear if the phrase is open ended or closed as it may be treated both ways. To render this rejection moot either the phrase "comprising" or "consisting of" should be used for open and closed sets of limitations respectively. Correction is required. See any of the cited references for the proper form of a claim according to current United States practice.

Claims 2 and 3 have limitations dealing with a plurality of reservoirs, but claim 1 has only "at least one reservoir". To further define the amount of reservoirs the claim should read something like "the at least one reservoir further comprises 4 reservoirs". Any time the "at least one reservoir is modified it must be specifically called out as being modified.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what structure is being claimed as this appears to be a method step of fixing two element together. The structure for doing this fixing should be positively recited.

Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. It is not clear what universally designed encompasses or leaves out. As the scope of this claim cannot be determined it is not being examined on the merits at this time. Clarification is required.

Claims 9,16,17,22 and 23 all have the phrase "preferably" which render the claims indefinite as it is not positively reciting any additional structure. As such the preferable arrangements are not being treated on the merits as they are not positively recited. Clarification is required.

Claim 12 recites the limitation "the roll-up gates" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 14-23 the handler is disclosed as being movable about "several degrees of freedom". However this is an indefinite term as several has no defined meaning in terms of absolute value. In the art rejections below any robot with more than two degrees of freedom is treated as meeting this limitation. Clarification is required.

Any claim not specifically called out if rejected under 35 U.S.C 112 based upon its dependency on another rejected claim. In the art rejections below the claims are treated as best understood by the examiner. The following parts are treated as admitted prior art: an arrangement of parts comprising a series of reservoirs, tray elements, a handling device filling and emptying devices for the trays. Page 1 of the

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instant specification clearly states that these are used in handling tobacco products in well known manners and arrangements. See line 25 on page 1 specifically.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields, Jr. et al. in view of the admitted prior art. Regarding claims 1 and 2 Fields, Jr. et al. US 6,479,786 teaches a cell like work space comprising:

at least one reservoir (145,185) for items to be handled;

at least one robot (120,175) for moving the items into a work area;

a station for filling a reservoir with completed items;

a robot (520) at said station;

wherein all parts of the system for a cell that are joined together with fences (150,545). Fields, Jr. et al. do not teach an arrangement with devices as in claim 1. The admitted prior art (as outlined above) teaches an arrangement of a working area comprising:

a plurality of reservoirs;

a plurality of trays loaded into said reservoirs;

a handling robot for moving said trays;

at least one filling and at least one emptying device for said trays;

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wherein as many or as few of each element above may be used. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Fields, Jr. with the devices taught by the admitted prior art in order to handle rod like objects.

Regarding claim 8 Fields, Jr. et al. also teaches that the reservoirs are stationary.

Claims 1,2,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of. Fields, Jr. et al. Regarding claims 1 and 2 The admitted prior art (as outlined above) teaches an arrangement of a working area comprising:

- a plurality of reservoirs;

- a plurality of trays loaded into said reservoirs;

- a handling robot for moving said trays;

- at least one filling and at least one emptying device for said trays;

wherein as many or as few of each element above may be used. The admitted prior art does not teach placing the elements into a cell arrangement.

Fields, Jr. et al. US 6,479,786 teaches a cell like work space comprising:

- at least one reservoir (145,185) for items to be handled;

- at least one robot (120,175)for moving the items into a work area;

- a station for filling a reservoir with completed items;

- a robot (520) at said station;

wherein all parts of the system for a cell that are joined together with fences (150,545). It would have been obvious to one of ordinary skill in the art, at the time of

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invention to provide the cell arrangement taught by Fields, Jr. in the arrangement taught by the admitted prior art in order to handle rod like objects automatically is an area where workers are not stationed and are also segregated from moving equipment thereby increasing the safety of the work area.

Regarding claim 8 the reservoirs of the admitted prior art are also either stationary or movable.

Regarding claim 9 the admitted prior art also teaches that each reservoir holds at least one tray for the rod shaped articles.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art and Fields, Jr. et al. as applied to claim 1 above, and further in view of Hanada et al. The admitted prior art does not teach any particular structure to the reservoirs. Hanada et al. US 4,827,691 teaches a system for holding and transferring rod shaped articles comprising:

a reservoir (142) for holding a plurality of trays(F);

said reservoir being selectively coupled to an inlet of a filling and emptying device;

wherein said reservoir may move between a plurality of different work areas as needed and said reservoir is a dolly for holding containers thereon. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by the admitted prior art with rolling resevoirs as taught by Hanada et al. in order to move surplus articles to a point in a production facility where they are needed and to

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move them from an area where they are not without requiring an operator to lift the trays.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art and Fields, Jr. et al. as applied to claim 1 above, and further in view of Van Der Meulen. The admitted prior art does not teach any particular structure to the interface between the reservoirs and the cell. Van Der Meulen US 6,585,470 teaches a work cell comprising:

- a handling device (74);
- a plurality of reservoirs for holding items;
- said reservoirs having a closable opening on a side facing the handling device;
- at least one selectively openable tray bay element (30) associated with each reservoir in said cell;

wherein said reservoir directly coupled to said tray bay element. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by the admitted prior art and Fields, Jr. et al. with an interface as taught by Van Der Meulen in order to seal off the entry to the cell when no reservoir was present, thereby increasing the security of the handling robot.

Claims 14-20,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art and Fields, Jr. et al. as applied to claim 1 above, and further in view of Boucher, Jr. et al. The admitted prior art teaches the limitations of claim 1 as above, they do not teach any particular structure to the gripping element. Boucher, Jr. Et al. teaches a material handling device with a gripping and holding device comprising:

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a carrying element (62,64) attached to a linear drive mechanism;

a holding element (16) for objects to be moved;

said carrying element being two suction devices with at least two buffer elements thereon;

wherein said suction elements can affix themselves to a smooth outer surface of an object such that the linear drive may push or pull the object;

wherein said holding element further has supporting elements (54 and 16a,16b);

wherein all supporting elements are movable;

a pair of sensor elements (18) for determining the location of an object to be moved relative to the suction elements. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the handler taught by the admitted prior art with a gripping device as taught by Boucher, Jr. et al. in order to pick up and move smooth sided objects without damaging them.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, Fields, Jr. et al. and Boucher, Jr. et al. as applied to claim 14 above, and further in view of Hebels et al. The admitted prior art, Fields, Jr. et al. and Boucher, Jr. et al. teach the limitations of claim 14 as above, Boucher, Jr. et al. also teach a second fixing unit (64), they do not teach a sensor for determining the status of the trays. Hebels et al. US 6,478,137 teaches a device for handling trays of rod shaped articles wherein the handler has a sensor (54) that can determine the fill status of a tray as well as determine the property of objects within the tray. It would have been obvious to one of ordinary skill in the art, at the time of invention to provide

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the handler taught by the admitted prior art with a sensor as taught by Hebels et al. in order to allow the device to automatically move trays only after they are ready thereby decreasing the chance of prematurely releasing the rod shaped articles into the manufacturing stream.

Allowable Subject Matter

Claims 6 and 7 are would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest a cell structure with reservoirs that interface with a roll up gate for access to the cell.

Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. It would not be an obvious variation to provide the device taught by Boucher et al. with spring elements on the supporting members.

The prior art made of record and not relied upon, but considered pertinent to applicant's disclosure is listed on the attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 571-272-6923. The examiner can normally be reached on 7:00-4:00 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on 571-272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Fox/
Primary Examiner, Art Unit 3652